

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES J. COULAS SR.

Appeal No. 2002-1677
Application No. 08/944,817

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11 and 14 to 16. Claim 17 has been withdrawn from consideration. Claims 12 and 13 have been canceled.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to flanges for connecting piping to various components such as pumps, valves, tanks, heat exchangers and so forth (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Calvin	5,188,396	Feb. 23, 1993
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Claims 1 to 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete.

Claims 1 to 3, 6 to 9 and 14 to 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Calvin.

Claims 4, 5, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Calvin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 19, mailed February 26, 2001) and the answer (Paper No. 25, mailed December 12, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 24, filed November 20, 2001) and reply brief (Paper No. 28, filed February 12, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 11 under 35 U.S.C. § 112, second paragraph.

In the rejection of claims 1 to 11 under the second paragraph of 35 U.S.C. § 112, the examiner (final rejection, pp. 3-4) concluded that these claims were incomplete for omitting essential elements, such omission amounting to a gap between the elements.

The examiner identified the omitted element as a clamp which, at a minimum, appears to be necessary to assemble the claimed elements into a single system.

The appellant argues (brief, p. 7; reply brief, p. 3) that claims 1 to 11 provide a reasonable degree of precision and particularity in reciting the claimed subject matter and thus comply with the requirements of the second paragraph of 35 U.S.C.

§ 112.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner

of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, it is our opinion that claims 1 to 11 comply with the requirements of the second paragraph of 35 U.S.C. § 112. In that regard, while the claims do not positively recite a clamp (as in claims 13 to 16), we do not see that such is dictated by the language of 35 U.S.C. § 112, second paragraph.

Claim 1, for example, is drawn to a pipe-to-component connector system, comprising, inter alia, a forged flange and a metallic piping segment. We see no requirement in the language of the second paragraph of 35 U.S.C. § 112 for claim 1 to further recite a clamp to connect and the forged flange and the metallic piping segment together. Claim 1 is clearly drawn to a pipe-to-component connector system having a forged flange and a metallic piping segment and as such define the metes and bounds thereof with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. Thus, the invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001);

Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1480, 1 USPQ2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 107 S.Ct. 2490 (1987); In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

In the anticipation rejection before us in this appeal, the examiner (final rejection, p. 2) ascertained that Figure 2 of Calvin

shows a pipe-to-component connector system comprising: a forged (see "wrought" in col. 1, line 30) steel (which is a material in accordance with ASTM Std A105, see p.22 item 4.1 of the standard.) flange 26 with an extended neck 14 with a circumferential groove and a raised portion; and a metallic piping segment "P" with a circumferential groove. The grooves are shown as cooperating in order to receive a clamp 24. In col. 6, Calvin discloses that flange 26 is made according to U.S. standards.

The appellant argues (brief, pp. 4-5; reply brief, p. 2) that the claimed "forged flange" limitation present in each of claims 1 to 3, 6 to 9 and 14 to 16 is not met by Calvin's section 14 having a flange 26. We agree. While Calvin teaches (column 1, lines 24-29) that "[i]t is well know that hardened metal has superior abrasion resistance, and that a wrought metal housing has desirable strength properties. U.S. Pat. No. 5,044,670, issued to Alexander Esser on Sep. 3, 1991, exemplifies the use of hardened metal wear surfaces and a wrought steel outer member," Calvin does not teach that sections 14 with flanges 26 are made from a hardened/wrought/forged metal. Accordingly, we can not support the examiner's rationale for the rejection of claims 1 to

3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b). For this rationale to have been proper, Calvin must clearly and unequivocally disclose the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the specific teachings of Calvin. Such picking and choosing **may** be proper in the making of a 35 U.S.C. § 103, obviousness rejection, where the appellant will be afforded an opportunity to rebut with objective evidence any rejection under 35 U.S.C. § 103, but it has no place in the making of a 35 U.S.C. § 102 anticipation rejection. See In re Arkley, 455 F.2d at 587, 172 USPQ at 526.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 4, 5, 10 and 11 under 35 U.S.C. § 103.

In the rejection of dependent claims 4, 5, 10 and 11 under 35 U.S.C. § 103, the examiner determined (final rejection, p. 4) that the claimed rectangular grooves would have been obvious at the time the invention was made to a person of ordinary skill in the art.

The appellant argues (brief, p. 6) that the claimed "forged flange" limitation present in each of claims 4, 5, 10 and 11 is not met by Calvin. We agree for the reasons set forth above. Moreover, in the rejection under 35 U.S.C. § 103 before us in the appeal, the examiner has not determined that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have made Calvin's sections 14 from a forged material. Thus, the examiner has not established a basis for concluding that the claimed subject matter is unpatentable under 35 U.S.C. § 103.

For the reasons set forth above, the decision of the examiner to reject claims 4, 5, 10 and 11 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner to consider whether or not the claims pending in this application are patentable under 35 U.S.C. § 103 over the appellant's admission of prior art (specification, pages 2-3)¹ in view of the prior art teaching of the use of a clamp to connect piping to a component/flange (e.g., Calvin).

¹ The admission relates to a forged flange for connecting piping to various components such as pumps, valves, tanks, heat exchangers, etc. wherein the piping is connected to the forged flange by welding and the forged flange is connected to the component by bolts.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 to 3, 6 to 9 and 14 to 16 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 4, 5, 10 and 11 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

REVERSED; REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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